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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Matthias Loeffler

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CLARIANT CORPORATION
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EXAMINER

BERNSHTEYN, MICHAEL

ART UNIT

PAPER NUMBER

1796

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/817,371	Applicant(s) LOEFFLER ET AL.	
	Examiner MICHAEL M. BERNSHTEYN	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-16, 18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-16, 18 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action follows a response filed on March 28, 2008. Claims 1, 4, 5, 6, 8, 10-13, 15 and 16 have been amended; claims 18 and 19 have been or added.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 28, 2008 has been entered.
3. Claims 1-8, 10-16, 18 and 19 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-8, 10-16, 18 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim 1 contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amended claim 1 recites, "B) subsequently adding the higher-boiling solvent or solvent mixture, the one or more emulsifiers or the mixture thereof to the mixture of copolymer and polymerization

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medium from Step A) without isolating the copolymer from the polymerization medium”, which was not described in the specification at all. The specification only discloses that “the major part of the tert-butanol is then removed by distillation with good stirring. By applying a vacuum, the tert-butanol residues are removed from the mixture” (page 12, lines 12-14).

Claim Rejections - 35 USC § 103

5. The text of this section of Title 35 U.S.C. not included in this action can be found in a prior Office Action.

6. Claims 1-8 and 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable as obvious over Loffler et al. al. (U. S. Patent Application Publication 2001/0029287, now U. S. Patent 6,437,068) in view of CU Boulder Organic Chemistry Undergraduate Courses (<http://orgchem.colorado.edu/hndbkssupport/solremoval/solvremoval.html>), for the rationale recited in paragraph 5 of Office action dated November 28, 2007, and comments below.

7. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable as obvious over Loffler et al. al. (U. S. Patent Application Publication 2001/0029287, now U. S. Patent 6,437,068) in view of CU Boulder Organic Chemistry Undergraduate Courses (<http://orgchem.colorado.edu/hndbkssupport/solremoval/solvremoval.html>).

With regard to the limitation of instant claims 18 and 19, Loffler discloses that as result of the polymerization in alcohol or alcohol mixture with **a water content** of less than 10% by weight and here in particular in **tert-butanol**, products are obtained, with

regard to their residual content of solvent remaining in the product, are toxicologically safe and can be thus used, for example, in cosmetic products (page 1, [0009]).

Response to Arguments

8. Applicant's arguments filed on March 28, 2008 have been fully considered but they are not persuasive.

9. It appears that the focal Applicants argument again resides in the contention that the polymerization medium is not removed from the resulting reaction mixture before the solvent or solvent mixture, the one or more emulsifiers, or the mixture thereof was added. Such a method is not taught or suggested by the teachings of the Loftier reference and the undergraduate course reference, either alone or in combination, and is not obvious over the prior art of record (page 7, the last paragraph). Applicants contend that nowhere does the Loftier reference teaches or suggests to prepare an emulsion or another composition by adding an oil substance directly into a reaction mixture containing the copolymer and the polymerization medium and then removing the polymerization medium (page 8, 2nd paragraph).

10. It is worth to mention that Loffler fully discloses the limitations of claim 1 (III), steps A), B), and C)) concerning adding of a higher-boiling solvent or solvent mixture and one or more emulsifiers to the mixture of polymer and polymerization medium, and new limitations of claims 15 and 16 ("adding during Step B)", because most of the species in the prior art are correspondingly exactly the same as in instant claims 15 and 16 (compare instant claims 15 and 16, which describe in details all possible species for

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the higher-boiling solvent or solvent mixture, and US'287, pages 3-4, [0035]). The only difference concerns the used terminology: the prior art is silent about a **higher-boiling solvent** and named these species as **oil substances**.

With regard to the new limitations of III), step B) in claim 1, Loffler discloses that the adding of a higher-boiling solvent or solvent mixture and one or more emulsifiers to the mixture of polymer and polymerization medium is the next step after the formation of polymer of high molecular weight. Practically it can be done when the reflux condenser is replaced by a distillation bridge (compare the specification, example A, pages 11-12, [0034] and US'287, Example 1, page 3, [0024] and Examples 1-4 O/W cream, pages 4-5, [0042]-[0060]).

11. In the absence of showing the criticality of adding solvent or solvent mixture, the one or more emulsifiers or the mixture thereof to the mixture of copolymer and polymerization medium from Step A) without isolating the copolymer from the polymerization medium in step B), in view of substantially identical method of free radical polymerization between Loffler and instant claims, and substantially identical chemical ingredients, such as monomers, initiators, crosslinkers, emulsifiers, solvents (tert-butanol), higher-boiling solvents (or oil substances), temperatures, duration, etc. as instantly claimed, and being used for the same purposes for cosmetic, pharmaceutical and dermatological oil-in-water emulsion compositions, it is the examiner position that Loffler's process does not necessarily differ from the claimed process.

It is worth to mention again, that it is axiomatic that one who performs the steps of a process must necessarily produce all of its advantage. Mere recitation of a newly

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discovered property or function what is inherently possessed by the things or steps in the prior art does not cause a claim drawn to those things to distinguish over the prior art. **Leinoff v. Louis Milona & Sons, Inc.** 220 USPQ 845 (CAFC 1984).

12. It is noted that due to typing and coping errors the second paragraph on page 5 beginning with the words "With regard to the limitation of instant claims 18-19" and ending with the words "in order to obtain the desirable level" should be deleted.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael M. Bernshteyn whose telephone number is 571-272-2411. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael M. Bernshteyn/
Examiner, Art Unit 1796

/M. M. B./
Examiner, Art Unit 1796

/Randy Gulakowski/
Supervisory Patent Examiner, Art Unit 1796